

**REMARKS**

**INTRODUCTION:**

In accordance with the foregoing, claims 8 and 9 have been canceled, without prejudice or disclaimer. No new claims have been added and no claims have been amended.

Claims 1-7 are pending and under consideration. Reconsideration is respectfully requested.

**REJECTION UNDER 35 U.S.C. §103 OF CLAIMS 1-2 AND 5-8:**

At page 2 of the Office Action, claims 1-2 and 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "the applicant's admitted prior art" ("AAPA") in view of U.S. Patent No. 6,577,566 issued to Tomita ("Tomita"). Applicant traverses the rejection for at least the reasons discussed herein and reconsideration is respectfully requested.

Regarding claim 1, the rejection is traversed because the proposed combination of AAPA and Tomita fails to teach or suggest at least:

determining from which track the tracking error signal has been  
generated in response to the determination that the tracking error  
signal has been generated

The Office Action asserts the above-claimed feature is shown by FIG. 13C of Tomita. By way of review, FIGS. 13A –13C of Tomita set forth "the operating concept of a state of on-track along a land Ld as an operation of the tracking-servo control unit." Tomita goes on to describe the tracking, by the tracking-servo control unit, of a laser spot SP along the land Ld using the tracking-error signal TE. When the laser spot SP is shifted from the land Ld toward an inner circumference of the disc, the tracking-error signal TE increases in a plus direction relative to the 0-level target value, and when the laser spot SP is shifted from the land Ld toward an outer circumference of the disc, the tracking-error signal TE increases in a minus direction relative to the 0-level target value. *Tomita*, col. 24, lines 15-30.

Thus, the cited portion of Tomita discusses a tracking-error signal which reflects the relative motion of the laser spot towards and away from an inner circumference of the disc, but fails to discuss "determining from which track the tracking error signal has been generated" as in at least the above-identified claim. Accordingly, Applicant respectfully submits that independent claim 1 patentably distinguish over the cited reference, and should be allowable for at least the above-mentioned reasons.

If the above rejection is to be maintained, Applicant respectfully requests the Examiner provide a specific paragraph number and figure reference, or specifically indicate if an assertion of inherency is being relied upon.

Further, Applicant respectfully submits that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP 2142*. Further, the references must teach or suggest all the claim limitations. *MPEP 2143.01*.

Here, no citation to the prior art has been offered as providing a suggestion or motivation to modify Tomita, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the reference.

In fact, it appears the Examiner is relying on personal knowledge as the basis for the rejection. The personal knowledge of the Examiner, when used as a basis for a rejection, must be supported by an affidavit as to the specifics of the facts of that knowledge when called for by the applicant. *See MPEP 2144.03, 37 C.F.R. § 1.104(d)(2)*. In short, the rules of the PTO require that the Examiner must either support this assertion with an Affidavit, or withdraw the rejection.

Accordingly, Applicant requests that the record be supported by evidence of the underlying recited motivation. The Office Action appears to take Official Notice of the underlying required motivation, while the same must be supported in the record. Without the requested support, it is submitted that the rejection is improper and should be withdrawn.

Accordingly, Applicant respectfully submits that independent claim 1 patentably distinguish over the cited reference, and should be allowable for at least the above-mentioned reasons.

Further, Applicant submits that claims 2-7 which depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

#### REJECTION UNDER 35 U.S.C. §103 OF CLAIMS 3 AND 4:

At page 4 of the Office Action, claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Tomita further considered with U.S. Patent Publication No. 2002/0054974 by Takahashi et al. ("Takahashi"). At least for the reasons set forth herein,

this rejection is traversed and reconsideration is respectfully requested.

The Office Action asserts that in "regard to claims 3 and 4, the Applicant's admitted prior art and Tomita teach all the elements of claims 3 and 4 except" the features of dependent claims 3 and 4. However, claims 3 and 4 depend ultimately on independent claim 1, which as discussed above, recites features not taught or suggested by the proposed combination of AAPA and Tomita. Takahashi is not alleged to make up for this deficiency. Therefore, withdrawal of the §103 rejection is respectfully requested.

Further, the Applicant respectfully submits that the Office Action fails to provide a valid line of reasoning from the prior art to combine the teachings of Takahashi with AAPA and Tomita. Again, the Office Action appears to take Official Notice of the underlying required motivation, while the same must be supported in the record. Accordingly, Applicant requests that the record be supported by evidence of the underlying recited motivation, as discussed above.

Accordingly, withdrawal of the 103 rejection of claims 3 and 4 is respectfully requested.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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